

### **REMARKS**

By this Amendment, Applicants have amended claims 2, 7, 9, 11, 14, 16, 25, 27, 30, 31, 35-40, 42, and 45. No new matter has been added. The amendments to those claims have been made to conform them to the particularities of U.S. practice and/or to correct minor informalities of a typographical or grammatical nature, and are not intended to further limit the scope of those claims. The scope of the claims should be interpreted in that light.

As an initial matter, Applicants would like to thank Examiners Hasan and Sugarman for the courtesy and consideration extended to Applicants' representative during the personal interview conducted on December 7, 2004. During the interview, the following issues were discussed.

In the Office Action, the Examiner rejected claims 1-3, 6-8, 10, 12-16, 27, 29, and 31 under 35 U.S.C. § 102(b) as being anticipated by Ishibai et al. (U.S. Patent No. 5,166,830); rejected claim 17 under 35 U.S.C. § 103(a) as being unpatentable over Ishibai et al. in view of Miyamoto et al. (U.S. Patent No. 5,896,234); rejected claims 34 and 49 under 35 U.S.C. § 103(a) as being unpatentable over Ishibai et al. in view of Kitamura et al. (U.S. Patent No. 6,744,568); indicated that claims 28, 30, 32, 33, 43-48, and 52-54 are allowed; and indicated that claims 4, 5, 9, 11, 18-26, 35-42, 50, and 51 would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

As an initial matter, Applicants appreciate the Examiner's indication of allowed claims and allowable subject matter, although Applicants believe the Examiner's

indicated reason for allowing each claim is merely one reason the corresponding claim is allowable, and is not necessarily the only reason.

Concerning the rejection of claims 1-3, 6-8, 10, 12-16, 27, 29, and 31 under 35 U.S.C. § 102(b) based on Ishibai et al., the independent claims rejected are claims 1, 27, 29, and 31. During the interview conducted on December 7, 2004, Examiners Hasan and Sugarman indicated that independent claims 27, 29, and 31 are patentably distinguishable from the Ishibai et al. reference. Therefore, those claims should be allowable. With respect to the rejection of claim 1 under § 102(b) based on Ishibai et al., Applicants respectfully traverse that rejection because the Ishibai et al. reference does not disclose or suggest all of the subject matter recited in Applicants' independent claim 1.

#### Independent Claim 1

In the Office Action, the Examiner rejected claim 1 under 35 U.S.C. § 102(b) as being anticipated by the Ishibai et al. reference. Applicants respectfully traverse that rejection because the Ishibai et al. reference does not disclose all of the subject matter recited in Applicants' amended independent claim 1.

The M.P.E.P. advises that "[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." § 2131 (citation omitted). Since the Ishibai et al. reference fails to disclose or suggest all of the subject matter recited in Applicants' independent claim 1, claim 1 should be patentably distinguishable from Ishibai et al.

Applicants' invention as recited in amended independent claim 1 is directed to an objective lens for use in an optical pickup apparatus. The objective lens includes a first lens molded with a plastic and having an optically functional section, a flange section provided around the periphery of the optically functional section, and a first contacting section provided on the flange section. The objective lens further includes a second lens molded with a plastic, located opposite to the first lens and having an optically functional section, a flange section provided around the periphery of the optically functional section, and a second contacting section provided on the flange section. In addition, the first lens and the second lens are jointed in such a way that the first contacting section and the second contacting section are brought in contact with each other. Moreover, the first lens has a first surface and a second surface, and the second lens has a third surface and a fourth surface as an optically functional surface. When the objective lens has an object side and an image side, the first surface, the second surface, the third surface, and the fourth surface are arranged in this order from the object side and the first surface and the third surface are a convex surface, respectively. Furthermore, an outer diameter of the second lens is smaller than that of the first lens.

The Ishibai et al. reference does not disclose or suggest at least an objective lens including a first lens and a second lens, wherein the outer diameter of the second lens is smaller than that of the first lens.

Referring to Fig. 29 of the Ishibai et al. reference, the rejection statement asserts that Ishibai et al. discloses, among other things, "an objective lens . . . comprising: a first lens (L1') . . . and a second lens (L2') . . . wherein an outer diameter of the second lens (L2') is smaller than that of the first lens (L1') (column 10, lines 30-37)." Office Action

at 3. Applicants respectfully disagree with the rejection statement's assertion about what the Ishibai et al. reference discloses.

Looking to the reference itself, Ishibai et al. discloses an optical lens system L for use in combination with a bar code sensor, including first and second meniscus lenses L1' and L2' arranged back to back along an optical axis on object and image sides, respectively. The first and second meniscus lenses L1' and L2' are disclosed as being identical in configuration and optical characteristics. Referring to Fig. 29, the first lens L1' defines a recessed portion 46 formed along a peripheral portion of a flange 43.

During the interview conducted December 7, 2004, Examiners Hasan and Sugarman interpreted the Ishibai et al. reference as disclosing a first lens L2' and a second lens L1', wherein the outer diameter of the second lens L1' is smaller than that of the first lens L1'. The Examiners are apparently asserting that the recessed portion 46 of second lens L1' defines an outer diameter of the second lens L1', which is smaller than the outer diameter of the first lens L2'.

Applicants respectfully disagree with that interpretation at least because it is unreasonable to interpret the recessed portion 46 of Ishibai et al. as being an "outer diameter" of the second lens L1' because it is not, in fact, the outer diameter of lens L1'.

The M.P.E.P. advises that "[d]uring patent examination, the pending claims must be 'given their broadest reasonable interpretation consistent with the specification.'" § 2111 (citation omitted). The M.P.E.P. further advises that "[t]he broadest reasonable interpretation of the claims must . . . be consistent with the interpretation that those skilled in the art would reach." Id.

In that light, it is not reasonable to interpret the recessed portion 46 of the Ishibai et al. reference to be an “outer diameter,” since it defines a diameter that is smaller than the outer diameter of lens L1’. In fact, if the recessed portion 46 of lens L1’ were interpreted as being the “outer diameter,” how would a person having skill in the art characterize the diameter associated with the non-recessed portion, which has a larger diameter? Furthermore, the Ishibai et al. reference discloses that the two lens L1’ and L2’ are identical, except for the recessed portion 46 in lens L1’. Therefore, it is reasonable to interpret the Ishibai et al. reference as disclosing identical lenses L1’ and L2’ that have identical outer diameters, and that lens L1’ has a recessed portion 46. It is not reasonable, however, to interpret the Ishibai et al. reference as disclosing that identical lenses L1’ and L2’ have outer diameters that are different such that lens L1’ has a smaller outer diameter than lens L2’. In other words, if one having ordinary skill in the art were explaining aspects of the diameters of lenses L1’ and L2’ of Ishibai et al., that person would not reasonably be expected to refer to the recessed portion 46 of lens L1’ as the “outer diameter” of lens L1’. Therefore, Applicants respectfully submit that it is unreasonable to interpret the Ishibai et al. reference as disclosing a lens L1’ having an “outer diameter” defined by recessed portion 46 that is smaller than an outer diameter of lens L2’. Since the Ishibai et al. reference fails to disclose or suggest at least this subject matter recited in claim 1, Applicants’ independent claim 1 is patentably distinguishable from the Ishibai et al. reference.

### Independent Claims 34 and 49

In the Office Action, Applicants' independent claims 34 and 49 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Ishibai et al. in view of Kitamura et al. As discussed during the interview, the Kitamura et al. reference does not qualify as prior art with respect to Applicants' present application because the Kitamura et al. reference's first effective U.S. filing date, April 8, 2002, is subsequent to the January 18, 2002, filing date of U.S. application no. 10/050,560, to which the present application claims priority. Although this application is a continuation-in-part of U.S. application no. 10/050,560, Applicants' present independent claims 34 and 49 rely only on the subject matter contained in application no. 10/050,560. Therefore, the § 103(a) rejection of independent claims 34 and 49 cannot rely on the disclosure of the Kitamura et al. reference. In addition, Applicants do not necessarily agree with the § 103(a) rejection based on the Examiner's proposed hypothetical combination of the Ishibai et al. and Kitamura et al. references, even if the Kitamura et al. reference did qualify as prior art with respect to this application. For at least those reasons, Applicants respectfully submit that independent claims 34 and 49 should be allowable.

### Conclusions

For at least the reasons set forth above, independent claims 1, 27, 29, 31, 34, and 49 should be allowable. Dependent claims 2-26, 35-42, 50, and 51, depend from one of allowable independent claims 1, 34, and 49. Consequently, those dependent claims should be allowable for at least the same reasons the claim from which they depend is allowable. Furthermore, the Examiner indicated that claims 28, 30, 32, 33,

43-48, and 52-54 are allowed. Therefore, claims 1-54 should be allowable, and the present application should be in condition for allowance. Accordingly, Applicants respectfully request the reconsideration of this application, the withdrawal of the outstanding claim rejections, and the allowance of claims 1-54.

If the Examiner believes that a telephone conversation might advance prosecution, the Examiner is cordially invited to call Applicants' attorney at (571) 203-2739.


Applicants respectfully submit that the Office Action contains numerous assertions concerning the related art and the claims. Regardless of whether those assertions are addressed specifically herein, Applicants respectfully decline to automatically subscribe to them.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 6-0916.

Respectfully submitted,

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Dated: December 21, 2004

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